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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,711	07/02/2001	Keng Kit Yeo	PHN17.710	8614

7590

09/26/2002

Philips Electronics North America Corporation  
580 White Plains Road  
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EXAMINER

NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/869,711

Applicant(s)

YEO, KENG KIT

Examiner

Kimberly T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 15-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-14, drawn to an outer layer and an element with a carrier structure.

Group II, claims 15-23, drawn to a method of marking an outer layer.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a special technical relationship among those inventions involving one or more of the same corresponding technical features which define a contribution over prior art. The special technical feature of the present invention—a layer comprising a polymer material with an inorganic main chain and marked regions—does not define a contribution over the prior art, as is revealed by Birmingham, Jr. et al., U.S. Pat. No. 5,789,466 in the Abstract and column 3, lines 39-49 and column 5, lines 17-39. Consequently, a lack of unity of invention exists. See 37 CFR 1.475 and MPEP 1850.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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During a telephone conversation with Michael E. Marion on August 20, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

Claims 5, 6, 8-9, 11, and 14 are objected to because of the following informalities:

Claims 5, 6, 8-9, 11, and 14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-2, 4, 8, and 12-14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear what the “outer layer” belongs to.

In claim 1, the phrase “characterized by” is unclear and should be amended to “wherein.”

In claim 1, it is not clear what the “certain visual properties” are.

In claim 1, it is not clear how “a marking” is “formed by at least a region.”

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In claim 1, it is not clear what “the corresponding property of other regions” is. Further, there is insufficient antecedent basis for this limitation in the claim.

In claim 1, it is unclear what the “other regions of said outer layers” are.

The term "substantially" in claim 2 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 2, it is not clear what is meant by the phrase “substantially integral with other portions.”

In claim 4, it is not clear what is meant by the phrase “at least dull-translucent.” The term "dull" is a relative term which renders the claim indefinite. The term "dull" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 8, it is not clear how the claim shows at least two layers, yet the claim also shows that the “at least two layers are absent, with the exception of at least one layer thereof” in the at least one marked region. It is not clear if this claim actually shows only one layer.

The term "hard" in the phrase “a hard material of permanent shape” in claim 12 is a relative term which renders the claim indefinite. The term "hard" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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Regarding claim 12, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 12 recites the limitation "the material of the carrier structure." There is insufficient antecedent basis for this limitation in the claim.

In claim 13, it is not clear where the "anodized layer" is located in relation to the carrier structure and the outer layer.

In claim 14, it is not clear what the "at least one region (9)" is.

The term "substantially" in claim 14 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 14, it is unclear how the at least one region (9) can be "substantially unchanged" because it is not clear what process would change it.

In claim 14, it is unclear what and where the "zone adjoining the outer surface of said outer layer (3)" is and what and where the other "zone of surrounding areas of said outer layer (3) which adjoins an outer surface of said outer layer (3)." The two zones appear to be the same and thus, the outer layer (3) would be the same throughout the zones since they are "unchanged."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-7, 9-12, and 14** are rejected under 35 U.S.C. 102(b) as being anticipated by Birmingham, Jr. et al., U.S. Pat. No. 5,789,466.

Birmingham shows a laser marked coating composition on portions (laser-marked regions having certain visual properties visible to the human eye) of a substrate (carrier structure) which also comprises inorganic chains and matrices of fluoropolymers, TiO<sub>2</sub> and/or carbon black fillers (column 3, lines 39-49 and column 5, lines 21-39), and ceramic-type additives (column 4, lines 21-49). Birmingham shows that the surfaces are modified by laser irradiation and are transparent (column 1, lines 24-30) and can have oxide surface treatment (column 10, lines 50-67). Birmingham further shows that the fluoropolymers can comprise completely- or partially-fluorinated linear or branched alkyl and alkylene groups (column 3, lines 50-67) and vinyl-phenyl-methyl terminated dimethyl siloxanes (column 5, lines 20-39).

Claims 3, 5, and 6 are rejected because the phrases “is modified through the influence of laser radiation” in claim 3 and “formed by a sol-gel process” in claim 5 and “visual properties...can be changed by means of a laser” in claim 6 introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

**Claims 1-6, 8, 11-12, and 14** are rejected under 35 U.S.C. 102(b) as being anticipated by Robertson, U.S. Pat. No. 5,855,969.

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Robertson shows laser-marked coatings on a metal substrate (carrier structure) (column 1, lines 1-59) wherein the coatings comprises film-forming polymers with methyl and/or phenyl groups and pigments (visible visual property). Robertson shows that the matrix can be translucent and further comprises carbon black and TiO<sub>2</sub> fillers (column 5, lines 34-66).

Claims 3, 5, and 6 are rejected because the phrases "is modified through the influence of laser radiation" in claim 3 and "formed by a sol-gel process" in claim 5 and "visual properties...can be changed by means of a laser" in claim 6 introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Birmingham, Jr. et al., U.S. Pat. No. 5,789,466.

Birmingham is relied upon as above for claims 1, 11, and 12. Birmingham does not show a separate anodized/oxidized coating which supports the outer coating as in instant claim 13. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make one or more coatings on the substrate since it has been held that constructing



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a formerly integral structure into various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen  
Examiner  
September 24, 2002

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